

REMARKS

Claims 2-20, 24-42, 46-63 and 87-105 remain in this case for consideration. Claims 2, 4-11, 13-14, 16-17, 19-20, 24, 26-33, 35-36, 38-39, 41-42, 46, 48-57, 59-60, 62-63, 87, 89-95, 98-99, 101-102 and 104-105 have been amended to better define Applicants' invention. Claims 21-23, 43-45, 64-86 and 106-128 have been canceled, without prejudice, to expedite prosecution.

A. Prior Art Rejections

1. The Invention

Applicants have invented a data rating software application which can be programmed into a wireless device to help determine the charge assessed for wireless data communications. Unlike existing systems which calculate wireless communication charges by selecting, usually at the network server, a rate based upon distance or time-of-day and then multiplying that rate by the duration of the phone call, Applicants' data rating software application allows the wireless device itself to select one or more rates and one or more units of measure applicable to the data communication session as determined by type of data, the usage of the data, the source of the data, the service level selected, the service level achieved and/or the connection method wherein the units of measure include the quantity of bytes, quantity of data packets and/or the connection involved in the communication. In some embodiments, the selection of rates and units of measure is triggered by the data rating application detecting an event which takes place during the course of setting up the data communication session (e.g., a detected connection between the wireless device and the network).

2. The Cited Art Distinguished

Claims 2, 24, 46, 67, 87 and 109 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Lewis' U.S. Patent No. 5,684,861 ("Lewis patent"). The Lewis patent discloses a monitor which can be attached by a user to a cellular telephone to monitor calling charges. To use this monitor, the user programs information about his or her billing plan. The

monitor then evaluates telephone usage by detecting the duration of radio frequency signals from the cellular telephone antenna to the base station. By multiplying the duration of the phone call by the applicable billing plan information inputted by the user, the monitor can advise the user of the likely charges of the telephone call.

Lewis' monitor is much different from Applicants' invention. First of all, the Lewis monitor does not have a data rating application installed in a wireless device "capable of communicating within a network." Instead, Lewis' monitor is attached to, but separate from, the cellular telephone which communicates within the network.

Secondly, Lewis uses the standard prior art approach of selecting a billing rate based upon distance or time of day (e.g., peak or off-peak) and then multiplying that selected rate by the duration of the phone call. By contrast, Applicants' invention uses rating criteria which are independent of distance or time of day, such as the type of data, the usage of data, the source of data, the service level selected, the service level achieved and/or the connection method. Further, Applicants' invention uses metering criteria which are independent of the duration of the phone call, such as the quantity of bytes, quantity of data packets and/or the connection involved.

In a world where data can be sent at speeds varying from slow to lightning fast, Lewis' old fashioned approach to charging can produce anomalous results. Under Lewis' approach, for example, data which is sent in a fraction of a second over a DSL internet line is charged at a much lower rate than the same amount of data which takes an hour to send over a dial up internet connection. Applicants' invention allows transmission of the same quantity of data to be charged at the same rate regardless of whether it is sent slowly (e.g., dial up) or very quickly (e.g., DSL).

Thirdly, Applicants find no disclosure in the Lewis patent of the data rating application being triggered by a detected event or software application. For example, in Applicants' invention, if a DSL level of internet service is detected or used, the data rating application could impose a higher rate than if a dial up level of internet service is detected or used. The Lewis patent has no such flexibility. For these reasons, the Lewis patent would not anticipate any of Applicants' pending claims.

Claims 8, 16, 17, 18-23, 30, 38-39, 40-42, 44-45, 52, 59-63, 65-66, 71, 79-83, 85-86, 93, 101-105, 107-108, 113, 121-125 and 127-128 have been rejected under 35 U.S.C. § 103(a) as being "obvious" over the Lewis patent in view of various combinations of Applicants' so-called "admitted prior art", Drosset's U.S. Patent No. 6,662,231 ("Drosset patent"), Chuah's U.S. Patent No. 6,400,695 ("Chuah patent"), Solondz' U.S. Patent No. 6,192,248 ("Solondz patent"), Kaku's U.S. Patent No. 6,542,728 ("Kaku patent") and Dunn's U.S. Patent No. 5,625,877 ("Dunn patent").

On the issue of "obviousness," the Patent Office bears the burden of establishing a case of *prima facie* obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed.Cir. 1988). To determine whether or not the claimed subject matter can properly be viewed as "obvious" under 35 U.S.C. § 103, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved... Such secondary considerations as commercial success, long felt but unsolved need, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694, 15 L.Ed.2d 545 (1966). In order to properly combine references for an obviousness determination, there must be a suggestion or motivation in the references to make such a combination. *In re Gordon*, 733 F.2d 900, 902 (Fed.Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification"). With these legal principles in mind, the merits of the obviousness rejections will now be addressed.

The so-called "admitted prior art" pertains to maintenance of an accounting application, such as a user account, at a location external to the wireless device, such as the network. Nonetheless, Applicant is not aware of any disclosure in the prior art, including the Lewis patent and the so-called "admitted prior art," of a data rating application residing in the wireless device which can select one or more rates and one or more units of measure as determined by the type of data, the usage of data, the source of data, the service level selected, the service level achieved and/or the connection method wherein the unit of measure includes the quantity of bytes, quantity of data packets and/or the connection. Since the Lewis patent and the

so-called "admitted prior art" fails to provide this disclosure, none of Applicants' pending claims would be obvious over the Lewis patent in view of Applicants' so-called "admitted prior art."

The Drosset patent discloses a system where a user can obtain access to audio files which can then be stored in a user device. Charges in the Drosset patent are based upon the duration of play or the number of playouts. While the duration of play can either be measured at the network or in the user device, the network decides the unit of measure (i.e., whether duration of play or number of playouts) and the rate to be applied for that unit of measure (see, Drosset patent, col. 15, lns. 57-65). By contrast, in Applicants' invention, the unit(s) of measure and charge rate(s) are both selected by the data rating application *within the user's wireless device*. Further, Applicants' unit(s) of measure are independent of the "duration" of the data communication session. For these reasons, neither the Lewis patent nor the Drosset patent, either alone or in combination, would render as "obvious" any of Applicants' pending claims.

The Chuah patent discloses a method and apparatus for prioritizing access in a communications system. According to that portion of the Chuah patent relied upon by the Examiner, the service provider can give priority at their network servers to requests by favored customers (e.g., CEOs) at the expense of less favored customers. Applicants find no disclosure in the Chuah patent of installing a data rating application within the user's wireless device which selects both the unit(s) of measure and the charge rate(s) used to calculate data transmission charges. For these reasons, neither the Lewis patent nor the Chuah patent, either alone or in combination, would render as "obvious" any of Applicants' pending claims.

Like the Chuah patent, the Solondz patent describes a communication system in which the service provider can give priority (i.e., a higher "service priority level") at their network servers to requests by higher paying customers at the expense of lower paying customers. Nonetheless, Applicant finds no disclosure in the Solondz patent of installing a data rating application within the user's wireless device which selects both the unit(s) of measure and the charge rate(s) used to calculate data transmission charges. For these reasons, neither the Lewis patent nor the Solondz patent, either alone or in combination, would render as "obvious" any of Applicants' pending claims.

The Kaku patent discloses that the wireless service provider can vary the charge rate at their network servers depending upon the magnitude of transmission power used. The premise for Kaku's system is that a higher transmission power equates to a better quality of voice transmissions. Once a rate is chosen, though, Kaku uses the standard prior art technique of multiplying that rate by the duration of the telephone call to determine total charges. Applicants find no disclosure in the Kaku patent of installing a data rating application within the user's wireless device which selects both the unit(s) of measure and the charge rate(s) used to calculate data transmission charges. For these reasons, neither the Lewis patent nor the Kaku patent, either alone or in combination, would render as "obvious" any of Applicants' pending claims.

Finally, the Dunn patent discloses a wireless communication system in which the user device can request that the network server provide more bandwidth for a wireless communication so that the user can receive the communicated information more quickly. While Dunn discloses that, if the network server accepts the request, it can base its charges on the number of packets or the number of bits of information per packet being transmitted, it is still the network server which selects both the unit(s) of measure and the charge rate(s) used to calculate the data transmission charges. By contrast, in Applicants' invention, a data rating application is installed within the user's device to select both the unit(s) of measure and the charge rate(s) used to calculate data transmission charges. For these reasons, neither the Lewis patent nor the Dunn patent, either alone or in combination, would render as "obvious" any of Applicants' pending claims.

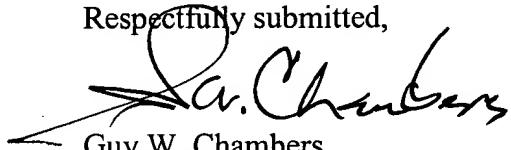
Appl. No. 09/911,868
Amdt. dated March 22, 2005
Reply to Office Action of September 22, 2004

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 576-0200.

Respectfully submitted,



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